

### **REMARKS**

Applicant hereby traverses the current rejections, and request reconsideration and withdrawal in light of the remarks contained herein. New claims 21-24 are provided for consideration. Claims 1-24 are pending in this application.

#### **New Claims 21-24**

New claims 21-23 depend from independent claims 1, 8, and 15 respectively, inheriting all limitations of their respective base claims. No new matter has been entered as basis for these claims exist in the present specification and drawings, for example see FIGURE 3 and at least page 10 line 29 to page 11 line 5 of the specification. New claims 21-23 set forth features and limitations not recited by the prior art of record. Thus, the Applicant respectfully asserts that new claims 21-23 should be indicated as being allowable over the prior art of record.

New claim 24 depends from independent claim 15, inheriting all limitations of its respective base claim. No new matter has been entered as basis for this claim exists in the present specification and drawings, for example see FIGURE 2 and at least page 11 lines 22-24 of the specification. New claim 24 sets forth features and limitations not recited by the prior art of record. Thus, the Applicant respectfully asserts that new claim 24 should be indicated as being allowable over the prior art of record.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 1, 2, 4, 5, and 7-14 are rejected as being unpatentable over Anderson, US 6,683,649 (hereinafter Anderson), in view of Kim, US 6,137,532 (hereinafter Kim).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Applicant respectfully asserts that the rejections do not satisfy all of these criteria.

### Lack of Motivation

It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP § 2143.01 VI. and *In re Ratti*.

Kim teaches using a look-up table to generate a color subcarrier to filter a component video signal with the hue, or color, being determined by the phase difference between the color subcarrier and a burst signal (Kim column 3, lines 16-20). Anderson teaches neither a color subcarrier nor a burst signal, rather, Anderson teaches using a YCC or RGB color format for still images (Anderson column 6, lines 45-50) and CCIR streaming video for moving images (column 5, lines 43-52).

In order to make the proposed combination either Kim or Anderson would have to be modified. Modifying Kim to generate YCC or RGB color and CCIR streaming video, instead of a color subcarrier changes the principle of operation of Kim, in that signal C2 would no longer be a color signal whose phase difference between a burst signal determines the hue. Modifying Anderson to use a color subcarrier and burst signal instead of YCC or RGB color and CCIR streaming video, changes the principle of operation of Anderson, in that the color subcarrier and burst signal are analog signals of a composite video signal that are incompatible with YCC or RGB color and CCIR streaming video.

Each of the rejections of claims 1, 2, 4, 5, and 7-14 depend on combining the teachings of Kim and Anderson. Kim and Anderson may not be combined without changing their principles of operation, as discussed above, and as such there is not motivation to combine their respective teachings. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejections of claims 1, 2, 4, 5, and 7-14 be withdrawn.

### Lack of Limitations

It is well established that in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03 and *In re Royka*.

Claim 1 recites “[a] digital camera comprising: ... a processor configured to process said pixel data in response to said selected image filter to provide filtered image data.” Anderson in view of Kim does not disclose at least these limitations. The rejection in pertinent part states:

Kim, 6,137,532, discloses a color filter device of a digital camera which comprises an input device (see figure2, element 222) configured to respond to a manual input selecting one of a plurality of image filters (see column 4, lines 7-10) and a processor (see figure 2, element 214) configured to process said pixel data in response to said selected image filter to provide filtered image data (see column 3, lines 21-27).

However, Applicant notes that Kim does not teach processing pixel data, in that the original color data C1 is discarded and new color data C2 is generated via a look-up table (Kim column 3 line 61 to column 4 line 7). Thus, Kim does not teach at least these limitations. The Office Action admits that Anderson does not teach these limitations. Therefore, Applicant respectfully asserts that claim 1 is patentable over Anderson in view of Kim and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

Claim 8 recites “[a]n apparatus for recording digital images comprising: ... a processor configured to perform an adjustment of the properties of said digital visual recording device to include selected ones of said filter effects.” Anderson in view of Kim does not disclose at least these limitations. The Office Action admits “Anderson does not disclose editing and displaying an image using digital color filtering” and then reads teachings of Kim onto limitations of claim 1. However, as discussed above, Kim does not teach the limitations of claim 1. Further, Kim does not address the limitation of including selected ones of said filter effects when adjusting the properties of said digital visual

recording device. Thus, Anderson in view of Kim does not disclose all the limitations of claim 8. Therefore, Applicant respectfully asserts that claim 8 is patentable over Anderson in view of Kim and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

Claims 2, 4, 5, 7, and 9-14 each depend from one of independent claims 1 or 8 and thus, each inherits all the limitations of their respective base claim. Claims 1 and 8 set forth features and limitations not recited in the prior art, as discussed above. Thus, Applicant respectfully asserts that for the above reasons claims 2, 4, 5, 7, and 9-14 are patentable over the 35 U.S.C. § 103(a) rejection of record.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 15-20 are rejected as being unpatentable over Kim in view of Anderson.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Applicant respectfully asserts that the rejections do not satisfy all of these criteria.

### **Lack of Motivation**

It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP § 2143.01 VI. and *In re Ratti*.

Kim teaches using a look-up table to generate a color subcarrier to filter a component video signal with the hue, or color, being determined by the phase difference between the color subcarrier and a burst signal (Kim column 3, lines 16-20). Anderson teaches neither a color subcarrier nor a burst signal, rather, Anderson teaches using a YCC or RGB color

format for still images (Anderson column 6, lines 45-50) and CCIR streaming video for moving images (column 5, lines 43-52).

In order to make the proposed combination either Kim or Anderson would have to be modified. Modifying Kim to generate YCC or RGB color and CCIR streaming video, instead of a color subcarrier changes the principle of operation of Kim, in that signal C2 would no longer be a color signal whose phase difference between a burst signal determines the hue. Modifying Anderson to use a color subcarrier and burst signal instead of YCC or RGB color and CCIR streaming video, changes the principle of operation of Anderson, in that the color subcarrier and burst signal are analog signals of a composite video signal that are incompatible with YCC or RGB color and CCIR streaming video.

Each of the rejections of claims 15-20 depend on combining the teachings of Kim and Anderson. Kim and Anderson may not be combined without changing their principles of operation, as discussed above, and as such there is not motivation to combine their respective teachings. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejections of claims 15-20 be withdrawn.

#### Lack of Limitations

It is well established that in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03 and *In re Royka*.

Claim 15 recites “[a] method of combining filter effects into digital photography, said method comprising: selecting a first filter on a digital recording device; selecting a second filter on a digital recording device; combining said first filter and said second filter to create a combined filtering effect.” Kim in view of Anderson does not disclose at least these limitations. The rejection in pertinent part states:

In regard to claim 15, Kim, US 6,137,532, discloses a method of combining filter effects into digital photography, said method comprising:

Selecting a first filter (see figure 3: R-Y) on a digital recording device;

Selecting a second filter (see figure 3: B-Y) on a digital recording device;

Combining said first filter and said second filter to create a combined filtering effect (see column 3, lines 51-60: Red green and blue are combinations of the color difference signals);

However, Applicant notes that Kim teaches “selecting a desired color” (column 2, line 55) instead of a first and a second filter. Further, the selected color is used as an address in a look-up table to generate a color signal C2 that has a constant phase difference between a burst signal to create the user selected color signal (column 3, line 61 to column 4, line 18), such that a single color is selected and a constant output signal C2 is generated. Thus, Kim does not teach selecting and combining the effects of a first and second filter. Anderson is not relied upon as teaching these limitations. Thus, Kim in view of Anderson does not teach all the limitations of claim 15. Therefore, Applicant respectfully asserts that claim 15 is patentable over Kim in view of Anderson and requests the 35 U.S.C. § 103(a) rejection of claim 15 be withdrawn.

Claims 16-20 each depend from independent claim 15 and thus each inherits all the limitations of claim 15. Claim 15 sets forth features and limitations not recited in the prior art, as discussed above. Thus, Applicant respectfully asserts that for the above reasons claims 16-20 are patentable over the 35 U.S.C. § 103(a) rejection of record.

**Claim Rejection – 35 U.S.C. § 103**

Claim 3 is rejected as being unpatentable over Anderson in view of Kim and further in view of Shiomi (US 6,650,361).

**Lack of Motivation**

The rejection of claim 3 depends on combining the teachings of Anderson, Kim, and Shiomi. Anderson and Kim may not be combined without changing their principles of operation, as discussed above regarding the rejection of claims 1, 2, 4, 5, and 7-14. The motivation cited is the rejection of claim 3 does not cure this deficiency and as such, there is no motivation to combine the teachings of the cited references. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 3 be withdrawn.

**Lack of Limitations**

Claim 3 depends from independent claim 1, inheriting all the limitations of claim 1. As noted above, neither Anderson nor Kim teach all the limitations of claim 1, either alone or in combination. Thus, claim 3 sets forth features and limitations not found in Anderson in view of Kim, as discussed above. Shiomi is not relied upon as teaching these limitations nor does it teach or suggest such limitations. Therefore, Applicant respectfully asserts that claim 3 is patentable over Anderson in view of Kim in further view of Shiomi and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

**Claim Rejection – 35 U.S.C. § 103**

Claim 6 is rejected as being unpatentable over Anderson in view of Kim and further in view of Safai et al. (US 6,167,469, hereinafter Safai).

**Lack of Motivation**

The rejection of claim 6 depends on combining the teachings of Anderson, Kim, and Safai. Anderson and Kim may not be combined without changing their principles of operation, as discussed above regarding the rejection of claims 1, 2, 4, 5, and 7-14. The

motivation cited in the rejection of claim 6 does not cure this deficiency and as such, there is no motivation to combine the teachings of the cited references. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 6 be withdrawn.

Lack of Limitations

Claim 6 depends from independent claim 1, inheriting all the limitations of claim 1. As noted above, neither Anderson nor Kim teach all the limitations of claim 1, either alone or in combination. Thus, claim 6 sets forth features and limitations not found in Anderson in view of Kim, as discussed above. Safai is not relied upon as teaching these limitations nor does it teach or suggest such limitations. Therefore, Applicant respectfully asserts that claim 6 is patentable over Anderson in view of Kim in further view of Safai and requests the 35 U.S.C. §103(a) rejection be withdrawn.



**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes a fee of \$200.00 is due with this response. However, if any additional fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10002214-1 from which the undersigned is authorized to draw.

Dated: January 5, 2006

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482723865US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: January 5, 2006

Signature: Donna Forbit  
(Donna Forbit)

Respectfully submitted,

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